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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,398	06/30/2003	Mariagrazia Pizza	PP00338.105	1890
27476 7590 07/02/2007 NOVARTIS VACCINES AND DIAGNOSTICS INC. CORPORATE INTELLECTUAL PROPERTY R338 P.O. BOX 8097 Emeryville, CA 94662-8097			EXAMINER GRASER, JENNIFER E	
			ART UNIT 1645	PAPER NUMBER
			MAIL DATE 07/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/611,398

Applicant(s)

PIZZA ET AL.

Examiner

Jennifer E. Graser

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 10-25 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 19-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/11/05, 3/19/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-4 and 15-25, Species 3 E.coli heat labile toxin subunit A with a mutation through substitution of Asn or Gly, in the reply filed on 3/21/07 is acknowledged. Claims 1-4, 19-23 and 25 read on the elected invention. The traversal is on the ground(s) that it would not be burdensome to search all of the groups together. They argue that one search would reveal all relevant art. This is not found persuasive because the inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product can be utilized in methods of screening for antibodies directed to the immunogenic protein (affinity purification of antibodies or in detection methods), in methods of making molecular image polymers and in methods of screening for modulating products that evidence protease activity as the claimed immunogenic protein could be used as a substrate. The inventions Groups I and Group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case that the process as claimed can be used to make another and materially

Art Unit: 1645

different product, wherein pharmaceutically acceptable carriers are known to be used in diagnostic methods in association with detection reagents, such as the immunogenic detoxified protein, and therefore the process could be used to formulate detection kit reagents, or a diagnostic composition. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner to examine all of the groups together because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

The Examiner is in agreement with applicants that in the former Examiner's species restriction Species 1 and 2 are duplicative and Species 4 and 5 are duplicative.

Claims 10-18 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Claim 15-18 and 24 are drawn to the non-elected Cholera toxin.

Claims 1-4, 19-23 and 25 are currently under examination.

The requirement is still deemed proper and is therefore made **FINAL**.

Specification

2. The disclosure is objected to because of the following informalities:

In the amendment to the specification on page 1, after the title, the current status of all listed applications needs to be updated. For example, 09/819, 917 and 08/981,208 are now abandoned.

Appropriate correction is required.

Priority

Art Unit: 1645

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

- The benefit claim in the instant Application (10/986,582) does not include the relationship between the recited Applications in the first sentence of the Specification.
- There is no copendency between Application serial number 08/823,120 (issue date 2000) and Application serial number 09/819,917 (filing date March 2001).
- The intermediate Application 08/981,208 did not claim benefit to Application serial number 08/823,120.

4. This application is claiming the benefit of prior-filed nonprovisional application No. 08/823,120 and 08/256,003 under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

5. This application repeats a substantial portion of prior Application No. 08/981,208, filed 12/22/1997, and adds and claims additional disclosure not presented in the prior

Art Unit: 1645

application; it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

6. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in Italy MI 91 A 03513 on December 21, 1991. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

Claim Rejections - 35 USC § 112-2nd paragraph

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-4, 19-23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4, 19-23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP§ 2172.01. The omitted structural cooperative relationships are: All of the claims recite the phrase "the amino acid at, or in positions corresponding to". While it is clear that the amino acid at position Ser-63 and Arg-192 are to be replaced, the instant Specification has not provided a definition for determining what a

Art Unit: 1645

corresponding position is, nor provides a structural cooperative relationship to be able to ascertain what or where a corresponding position is. The claims as they stand are incomplete and fail to provide adequate structural properties to allow for one to identify what is being claimed.

Claims 1-4, 19-23 and 25 recite an immunogenic detoxified protein comprising mutations; however, the claim does not state the protein has been isolated and/or purified. Accordingly, the claim may potentially read on naturally occurring mutants. This does not appear to be Applicants' invention. Correction is required.

Claim Objections

9. Claims 1-4, 19-23 and 25 are objected to because of the following informalities:

The claims contain non-elected subject matter (claim 1) which must be removed from the claim. Appropriate correction is required.

Claim 19 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. If this claim is cancelled, then claim 20 should be amended to depend from claim 1.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1645

10. Claims 1-4, 19-21, 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Dominighini et al (WO 93/13202) in light of evidence provided by Pizza (1994).

Dominighini et al disclose the instantly claimed invention directed to a an immunogenic detoxified protein comprising the amino acid sequence of the subunit A of an Escherichia coli heat labile toxin (LT-A, see claims 1-3) the protein having mutations at positions Ser-63-Lys and Arg-192-Asn and vaccine compositions comprising said protein. Dominighini also teaches that the detoxified protein has a toxicity less than 0.01% of the naturally occurring toxin counterpart, particularly because it is identical to that of the protein instantly claimed. Dominighini et al inherently anticipates the instantly claimed invention as now claimed in light of evidence provided by Pizza (1994) that teach Lys63 causes lose of toxicity (see (Table 1 and 2) and Arg-192-Asn decreases the rate of proteolysis and activation in vivo (see entire reference). Since the Office does not have the facilities for examining and comparing applicant's protein with the protein of the prior art, the burden is on applicant to show a novel or unobvious difference between the claimed product and the product of the prior art (i.e., that the protein of the prior art does not possess the same functional characteristics of the claimed protein). See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald et al.*, 205 USPQ 594. Inherently the reference anticipates the now claimed invention. *Atlas Powder Co. V IRECA*, 51 USPQ2d 1943, (FED Cir. 1999) states Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art...However, the discovery of a previously unappreciated property of a prior

Art Unit: 1645

art composition, or of a scientific explanation for the prior arts functioning, does not render the old composition patentably new to the discoverer. The Court further held that this same reasoning holds true when it is not a property but an ingredient which is inherently contained in the prior art.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Domenighini et al, as applied to claims 1-4, 19-21, 23 and 25 above, in view of Clements et al (US Pat. 6,019,982).

See discussion of Domenighini above. The reference teaches DNA molecules that encode mutant detoxified heat labile toxin of E.coli and mutant detoxified cholera toxin, wherein the mutations are in A-subunit in positions 63 and 192, but differs from the instantly claimed invention by failing to show the codon mutation at position 192 to be a mutation from Arg-192 to Gly- 192. Clements et al show DNA that encodes a mutant detoxified heat labile toxin of E.coli and mutant detoxified cholera toxin, wherein the mutation at position 192 is mutation from Arg-192 to Gly-192 in an analogous art for the purpose of obtaining a detoxified protein that still evidences adjuvant activity for induction of an enhanced immune response. It would have been prima facie obvious to the person of ordinary skill in the art at the time the invention was made to modify the

Art Unit: 1645

mutation of Domenighini at position 192 from Asn to Gly as taught by Clements, because Clements and Domenighini et al are both directed to the site directed mutagenesis of heat labile toxin of E.coli at position 192, and Clements et al teaches the advantage of substituting Gly at position 192 as yielding a stable, detoxified, mutant that is devoid of ADP-ribosyl transferase activity, but retains its activity as an immunological adjuvant (see Clements, col. 8, lines 24-27 and 28-50). The person of ordinary skill in the art would have been motivated to substitute the amino acid for Gly at position 192, because the resultant protein/polypeptide would lack the potential to become toxic due to proteolytic activation, resulting in "no real or potential side-effects, such as diarrhea, associated with its use (see col. 10, lines 5-14). In the absence of a showing of unexpected results, Domenighini et al in view of Clements et al obviate the instantly claimed invention.

Claim Rejections - 35 USC § 112-Scope of Enablement

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 1, 3, 4, 19, 23 and 25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for immunogenic, detoxified proteins comprising the amino acid of subunit A of an E.coli heat labile toxin (LT-A) wherein the amino acids at positions Ser-63 and Arg-92 of SEQ ID NO:7 are replaced with another amino acid, and further wherein the amino acid at position Ser-63 is replaced with Lys-63 and the amino acid at position Arg-192 is replaced with Asn-192 or Gly-192", does

Art Unit: 1645

not reasonably provide enablement for immunogenic, detoxified proteins comprising **any** amino acid replacement at Arg-192 as instantly claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The claims recite that a change may be made to position Arg-192 without reciting the substitution which provides for the functional limitations. The specification is not enabled for this broadly claimed invention.

The specification states that substitutions, additions, or deletions, may be made to the defined sequences; however, the specification provides no guidance as to what the amino acids may be changed without causing a detrimental effect to the toxin and with the added features of being immunogenic and protective, e.g., vaccine. It is unpredictable as to which amino acids could be removed and which could be added to position 192. While it is known that many amino acid substitutions are possible in any given protein, the position within the protein's sequence where amino acid substitutions can be made with a reasonable expectation of success are limited. Other positions are critical to the protein's structure/function relationship, e.g., such as various positions or regions directly involved in binding, catalysis in providing the correct three-dimensional spatial orientation of binding and catalytic sites. These regions can tolerate only very little or no substitutions. Selective point mutation to one key residue could eliminate the function of the polypeptide. It could eliminate its functional properties. If the range of decreased binding ability after single point mutation of a protein antigen varies, one

Art Unit: 1645

could expect point mutations in the protein antigen to cause varying degrees of loss of protection/function, depending on the relative importance to the binding interaction of the altered residue. Alternatively, the combined effects of multiple changes, as instantly claimed, in an antigenic determinant could again result in loss of function. A protein having multiple antigenic sites, multiple point mutations, or accumulated point mutations at key residues could create a new antigen that is precipitously or progressively unrecognizable by any of the antibodies in the polyclonal pool. As stated above, Applicants have not shown the particular substitution and the result it produces, with the exception of Arg-192 to Asn or Gly. Applicants have provided no guidance to enable one of ordinary skill in the art how to determine, without undue experimentation, the effects of different amino substitutions and the nature and extent of the changes that can be made. It is expensive and time consuming to make amino acid substitutions at more than one position, in a particular region of the protein, in view of the many fold possibilities for change in structure and the uncertainty as to what utility will be possessed. See Mikayama et al. (Nov.1993. Proc.Natl.Acad.Sci. USA, vol. 90 : 10056-10060) which teaches that the three-dimensional structure of molecules is important for their biological function and even a single amino acid difference may account for markedly different biological activities. Rudinger et al. (June 1976. Peptide Hormones. Biol.Council. pages 5-7) also teaches that amino acids owe their 'significance' to their inclusion in a pattern which is directly involved in recognition by, and binding to, the receptor and the significance of the particular amino acids and sequences for different amino acids cannot be predicted *a priori*, but must be determined from case to case by

Art Unit: 1645

painstaking experimental study. The instant claims allow for substitutions with amino acids of vastly different properties and they do not recite the specific changes in the claims.

Given the lack of guidance contained in the specification regarding acceptable amino acid substitutions, one of skill in the art could not make or use the broadly claimed invention without undue experimentation.


15. Correspondence regarding this application should be directed to Group Art Unit 1645. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Remsen. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1645 Fax number is 571-273-8300 which is able to receive transmissions 24 hours/day, 7 days/week.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Graser whose telephone number is (571) 272-0858. The examiner can normally be reached on Monday-Thursday from 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached on (571) 272-0787.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-0500.


Jennifer Graser
Primary Examiner
Art Unit 1645
6/21/07